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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/683,560	10/09/2003	Jun Tian	P0879	7905

23735 7590 09/22/2006

DIGIMARC CORPORATION
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EXAMINER

DANG, DUY M

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/683,560

Applicant(s)

TIAN, JUN

Examiner

Duy M. Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-20 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-20 and 25-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment filed on July 07, 2006 has been entered and made of record.
2. Currently claims 8-20 and 25-33 are pending.

Response to Arguments

3. Applicant's arguments, see page 6 line 11 to page 13 line 10 of Applicant's response filed July, 07, 2006, with respect to the rejection of pending claims 8-20 under 35 U.S.C 102(e) have been fully considered and are persuasive. Therefore, the applied reference to U.S. Patent No. 6,487,301 to Zhao et al. is no longer qualified as a prior art and the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as follows.

Specification

4. Applicant is required to update the information (issue date and patent numbers) with regard to the status of the co-pending application disclosed at page 1 lines 3-10 of the specification.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 8-20 and 25-33 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,683,966 (referred as the patent '966 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Regarding claim 8 as a representative claim, patented claim 1 of patent '966 teaches:
an apparatus component which uses first information in at least a first frequency component of the frequency components to produce first authentication information (see column 14 lines 1-4: note that hash refers to the so called "authentication information"); and incorporator which incorporates the first authentication information into at least a second frequency component of the frequency components that is separated from the first frequency component (see column 14 lines 5-6. Note that the one frequency transform region and another frequency transform region respectively correspond to the so called "first frequency component" and "second frequency component").

While application claim 8 is an apparatus claim and the patented claim 1 is a method claim, however, given the considerable level skill in the art, one in skill in the art would have found it obvious to make and use an apparatus for performing the method defined by the application claim 1. Furthermore, application claim 8 of the instant application is a broader recitation of the invention and each of the claims 1-20 of the patent '966 covers the equivalent subject matter as that of claim 8 of the instant application. Specifically, each of the limitations of claim 8 of the instant application is set forth in claim 1, for example, of the patent '966 as

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pointed out above. Therefore, claim 8 of the instant application fails to define an invention that is patentably distinct from each of claims 1-20 of the patent '966.

Application claim 25 is also rejected for the same reasons set forth in application claim 8 above.

Regarding claims 9-20 and 26-33, it is also noted that this claims calls for a broader recitation of the instant invention and the claims 1-20 of the patent '966 cover the equivalent subject matter as that of claims 9-20 and 26-33 of the instant application. Specifically, each of the limitations of claims 9-20 and 26-33 of the instant application is variously set forth in each of claims 1-20 of the patent '966. While each of the patented claims 1-20 includes additional limitations not set forth in claims 9-20 and 26-33 of the instant application, the use of transitional term "comprising" in each of the instant claims 9-20 and 26-33 fails to preclude the possibility of additional elements. Therefore, each of claims 9-20 and 26-33 of the instant application fails to define an invention that is patentably distinct from each of claims 1-20 of the patent '966.

7. Claims 8-20 and 25-33 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,714,683 (referred as the patent '683 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Regarding claims 8-20 and 25-33, it is also noted that this claims calls for a broader recitation of the instant invention and the claims 1-28 of the patent '683 cover the equivalent subject matter as that of claims 8-20 and 25-33 of the instant application. Specifically, each of the limitations of claims 9-20 and 26-33 of the instant application is variously set forth in each of

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claims 1-28 of the patent '863. While each of the patented claims 1-28 includes additional limitations not set forth in claims 8-20 and 25-33 of the instant application, the use of transitional term "comprising" in each of the instant claims 8-20 and 25-33 fails to preclude the possibility of additional elements. Therefore, each of claims 8-20 and 25-33 of the instant application fails to define an invention that is patentably distinct from each of claims 1-20 of the patent '966.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M. Dang whose telephone number is 571-272-7389. The examiner can normally be reached on Monday to Friday from 6:00AM to 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew C. Bella can be reached on 571-272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dmd
9/06


DUY M. DANG
PRIMARY EXAMINER